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EXAMINER	
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL-DAVID MORRISON and GERARDO GARCIA

Appeal 2009-000401
Application 09/738,050
Technology Center 2100

Before JOHN A. JEFFERY, ST. JOHN COURTENAY, III, and STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(1) (hereinafter "Request") for reconsideration of our Decision mailed June 29, 2010 (hereinafter "Decision"), in which we affirmed the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Wical and Suzuki.

We have considered the Request but we find Appellants have not identified any points that the Board has misapprehended or overlooked therein. Therefore, the Request is DENIED with respect to making any modifications in the decision.

ISSUE

Appellants request that "arguments presented in the Reply Brief shall also be considered" (Req. 3).

Thus, the issue before us is whether arguments presented for the first time in a Reply Brief that could have been presented earlier should be considered.

ANALYSIS

Appellants argue that new arguments presented in a Reply Brief that could have been presented earlier should be considered by the Board because, according to Appellants, "it is permissible for a reply brief before the Board to even raise an entirely new issue and to present associated new arguments. See 37 CFR 41.41 . . . and 41.43 . . ." (Req. 4). We disagree. While 37 C.F.R. § 41.43 may indicate that "the primary examiner may . . . furnish a supplemental examiner's answer" responding to new issues raised in a reply brief, Appellants have not demonstrated this rule to have any bearing on the Board. In fact, according to the plain language of the rule,

the rule only permits action on the part of the primary examiner and is silent as to any actions to be taken or not to be taken by the Board. Since neither 37 C.F.R. § 41.41 nor 37 C.F.R. § 41.43 requires consideration by the Board of new arguments presented for the first time in the Reply Brief that could have been presented earlier, we decline to do so since doing so would "vitiate the force of the requirement in Board Rule 37(c)(1)(vii) that '[a]ny arguments or authorities not included in the brief . . . will be refused consideration by the Board, unless good cause is shown[,]'" and "would also stand in stark contradiction to the general policy set out in Board Rule 41.1(b), which reads: '*Construction.* The provisions of Part 41 shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding before the Board.' 37 C.F.R. § 41.1(b) (2007)." *Ex parte Borden*, 98 USPQ2d 1473, 1476-77 (BPAI 2010) (informative).

Appellants also argue that "the Reply Brief presents arguments to rebut Examiner's rejections first raised in the Examiner's Answer" (Req. 4). However, the Examiner's initial findings (reproduced at Ans. 3-4) are re-iterated at Ans. 14-15. While Appellants broadly argue that the Examiner "raised a new issue by arguing that Appellant attacked the cited references separately" (Req. 3), Appellants have not demonstrated any specific Examiner findings presented for the first time in the Answer necessitating the specific new arguments in rebuttal in the Reply Brief. Nor do we find any substantial differences in the Examiner's initial findings and the Examiner's findings stated in the Answer that would warrant the new arguments presented in the Reply Brief for the first time.

Appellants also argue that "[t]he Reply Brief does not make an admission regarding whether an argument could have been presented

earlier" (Req. 6). In any event, whether Appellants made such an admission or not, as described above, arguments presented for the first time in a Reply Brief that could have been presented earlier will not be considered.

CONCLUSION

We have considered the arguments raised by Appellant in the Request for Rehearing, but find none of these arguments identify any points that the Board has misapprehended or overlooked. Nor do we find any of these arguments persuasive that our original Decision was in error. Therefore, we are still of the view that the invention set forth in claims 1-3, 5-23, 27-31, and 37-45 is unpatentable over the applied prior art based on the record before us in the original appeal. We have reconsidered our Decision but decline to grant the relief requested.

This Decision on Appellants' Request for Rehearing is deemed to incorporate our earlier Decision (mailed June 29, 2010) by reference. *See* 37 C.F.R. § 41.52(a)(1).

ORDER

We have granted Appellant's request to the extent that we have reconsidered our Decision of June 29, 2010, but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See also* 37 C.F.R. § 41.52(b).

REHEARING DENIED

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